Application No. 09/112,318. Applicant respectfully requests acknowledgment of the claim for foreign priority and the receipt of the certified copy.

Claims 29-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,765,170 (Morikawa) in view of U.S. Patent No. 5,619,648 (Canale et al.). Applicant submits that independent Claims 29, 34 and 39, together with the remaining claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

The aspect of the present invention set forth in Claim 29 is a communication device. Reception means is included for sending a transmit request to an e-mail server and receiving an e-mail from the e-mail server in response to the transmit request. Acquisition means is included for acquiring size information of an e-mail, stored in the e-mail server, from the e-mail server before sending the transmit request to the e-mail server. A memory stores e-mails received by the reception means. Judgment means is included for judging whether it is possible or not to receive at the communication device an e-mail stored in the e-mail server, according to the size information and an empty capacity of the memory. Output means is included for visually outputting warning information indicating that an e-mail to the communication device, stored in the e-mail server, cannot be received, as a result of a judgment by the judgment means.

Morikawa, as understood by Applicant, relates to an electronic mail processing system and method. Apparently, Morikawa classifies a data file, written in a received mail, based on specific data contained in the mail and stores the data file in an appropriate folder based on a result of the classification.

Canale et al., as understood by Applicant, relates to techniques for message

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filtering. Apparently, an e-mail filter uses non-address information contained in a received e-mail message and model information of a user to determine whether the e-mail message should be provided to the user.

One important feature of Applicant's Claim 29 is the acquisition means for acquiring size information of an e-mail, stored in the e-mail server, from the e-mail server before reception by the reception means. By virtue of this feature, it is possible to inform the user of whether or not an e-mail can be received before the reception process is started.

The Office Action cites Morikawa as disclosing the claimed acquisition means in Figure 1 at reference numeral 6. Applicant submits, however, that Morikawa makes no suggestion that e-mail size information stored in another server is acquired before reception. The mail server in Morikawa apparently is a data base having a plurality of folders for storing data associated with electronic e-mails determined by attachment-file analysis performed by an electronic mail terminal utility (see Figure 1, reference numeral 5). In regard to the mail-receiving operation of Morikawa, when an operator selects the receiving function, an electronic mail terminal utility makes inquiries to a host (see Figure 1, reference numeral 2) about the presence or absence of mail. If mail exists, the data processing system (see Figure 1, reference numeral 4) performs a reception process. It is after the reception processing that attachment-file analysis processing is performed on the received e-mail. When the data processing system receives the e-mail, the electronic mail terminal utility classifies a data file written in the e-mail according to specific data contained in the e-mail and stores the data file in an appropriate folder based on a result of the classification. It is at this point that e-mail size information is acquired by the receiving side. Applicant notes, however, that no apparent use is made of this

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information.

Further, Morikawa makes no suggestion that either a user mail server or an electronic mail terminal utility acquires e-mail size information stored in an e-mail server, from the e-mail server before reception. Furthermore, nothing has been found in Morikawa that is believed to teach or suggest "acquiring size information of an e-mail, stored in the e-mail server, from the e-mail server before sending the transmit request to the e-mail server," as recited in Claim 29. Canale et al. is not believed to remedy this deficiency of Morikawa.

Another important feature of Claim 29 is the judgment means for judging whether it is possible or not to receive at the communication device an e-mail stored in the e-mail server, according to the size information and an empty capacity of the memory.

The Office Action cites Morikawa as showing the claimed judgment means in Figs. 1 and 2; in column 2, line 34 to column 3, line 55; in column 6, line 2 to column 7, line 37; and in column 6, lines 15-67. As understood by Applicant, however, Morikawa does not reject e-mails based on comparing size information and an empty capacity of a memory, but rather automatically sorts data files of a plurality of mails that have been received based on a classification of the data files through attachment-file analysis. Files that are unable to be classified are stored in a shared folder (F0). Nothing in the cited portions of Morikawa is believed to relate to "judging whether it is possible or not to receive at said communication device an e-mail stored in the e-mail server, according to size information and an empty capacity of said memory," as recited in Claim 29. Canale et al. is not believed to remedy this deficiency of Morikawa.

Yet another important feature of Claim 29 is the output means for visually

outputting warning information indicating that an e-mail to the communication device, stored in the e-mail server, cannot be received, as a result of a judgment by the judgment means.

The Office Action states that while Morikawa does not specifically disclose the claimed output means, Canale et al. discloses such an element in Figs. 1 and 3; in the abstract; in column 3, line 12 to column 4, line 34; and in column 7, line 28 to column 8, line 56. The cited portions of Canale et al. are understood to relate to reducing the amount of junk e-mail received by a user and informing the user when regular e-mail is received. Apparently, this is accomplished by surpassing a threshold level to determine whether an e-mail request is appropriate. Nothing in Canale et al. is believed to teach or suggest "output means for visually outputting warning information indicating that an e-mail to said communication device, stored in the e-mail server, cannot be received, as a result of a judgment by said judgment means," as recited in Claim 29.

Applicant submits that a combination of Morikawa and Canale et al., assuming such combination would even be permissible, would fail to teach or suggest a communication device that includes "acquisition means for acquiring size information of an e-mail, stored in the e-mail server, from the e-mail server before sending the transmit request to the e-mail server," "judgment means for judging whether it is possible or not to receive at said communication device an e-mail stored in the e-mail server, according to the size information and empty capacity of said memory," and "output means for visually outputting warning information indicating that an e-mail to said communication device, stored in the e-mail server, cannot be received, as a result of a judgment by said judgment means," as recited in Claim 29.

Accordingly, Applicant submits that independent Claim 29 is patentable over

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the cited references and respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a). Independent Claims 34 and 39 are method and memory-medium claims corresponding to Claim 29, and are believed to be patentable for at least the same reasons discussed above with regard to Claim 29.
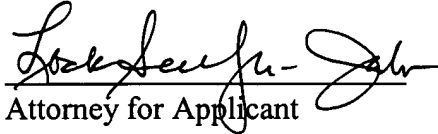
The other claims in this application depend from one or another of the independent claims discussed above, and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

This Amendment After Final Action is believed clearly to place this application in condition for allowance and, therefore, its entry is believed proper under 37 C.F.R. § 1.116. Accordingly, entry of this Amendment, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicant's undersigned attorney in an effort to resolve such issues and advance the case to issue.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE TO CLAIMS

29. (Twice Amended) A communication device comprising:

reception means for <u>sending a transmit request to an e-mail server and</u> receiving

an e-mail [at said communication device] <u>transmitted from the e-mail server in response to the</u>

<u>transmit request</u> [from an e-mail server];

acquisition means for acquiring size information of an e-mail, stored in the e-mail

server, from the e-mail server before [reception by said reception means] <u>sending the transmit</u>

<u>request to the e-mail server</u>;

a memory for storing e-mails received by said reception means;

judgment means for judging whether it is possible or not to receive at said

communication device an e-mail stored in the e-mail server, according to the size information

and an empty capacity of said memory; and

output means for visually outputting warning information indicating that an e-mail

to said communication device, stored in the e-mail server, cannot be received, as a result of a

judgment by said judgment means.

34. (Twice Amended) A communication method, comprising the steps of:

<u>sending a transmit request to an e-mail server and</u> receiving an e-mail <u>transmitted</u>

from an e-mail server <u>in response to the transmit request</u>;

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acquiring size information of an e-mail, stored in the e-mail server, from the e-

mail server before [said receiving step] <u>sending the transmit request to the e-mail server</u>;

storing e-mails received in said receiving step, in a memory;

judging whether it is possible or not to receive an e-mail stored in the e-mail

server, according to the size information and an empty capacity of the memory; and

visually outputting warning information indicating that an e-mail, stored in the e-

mail server, cannot be received, as a result of a judgment made in said judging step.

39. (Twice Amended) A computer-readable memory medium storing executable

code for performing a communication method that comprises the steps of:

<u>sending a transmit request to an e-mail server and</u> receiving an e-mail <u>transmitted</u>

from an e-mail server <u>in response to the transmit request</u>;

acquiring size information of an e-mail, stored in the e-mail server, from the e-

mail server before [said receiving step] <u>sending the transmit request to the e-mail server</u>;

storing e-mails received in said receiving step, in a memory;

judging whether it is possible or not to receive an e-mail stored in the e-mail

server, according to the size information and an empty capacity of the memory; and

visually outputting warning information indicating that an e-mail, stored in the e-

mail server, cannot be received, as a result of a judgment made in said judging step.